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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : David J. Boothby
Serial No. : 09/240,563
Filed : January 29, 1999
Title : SYNCHRONIZATION OF DISPARATE DATABASES

Art Unit : 2771
Examiner : C. Rones

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Technology Center 2100

Commissioner for Patents
Washington, D.C. 20231

RESPONSE

This is responsive to the office action mailed March 27, 2001.

Applicant appreciates the examiner's position on the double patenting rejection, but would once again urge the examiner to reconsider and withdraw the rejection.

The "office policy" of requiring a terminal disclaimer even when two patents will expire on the same day, is not supported by statute or judicial authority. The policy was created by the PTO several decades ago in the wake of judicial decisions dealing with "double patenting". The harm addressed in those decisions had to do with extending the term of the original patent if a second patent with a longer term were to issue for essentially the same invention. The PTO created the terminal disclaimer as a technique for neutralizing that harm so that a second patent could issue. In doing so, it required not only that the excess term be disclaimed but that ownership of the two patents remain identical during the term of the patent. The PTO had authority from the judicial decisions to require the disclaimer of term, but it had no authority to require the common ownership. As the excess term is now a moot issue in light of the changes to patent term that were made in connection with the adoption of the GATT several years ago, the PTO's unauthorized policy of requiring common ownership should end.

Accordingly, the examiner is asked to withdraw the rejection, and allow the application, or alternatively to issue a final rejection, from which an appeal can be taken.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

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Attorney Docket No.: 05110-003004

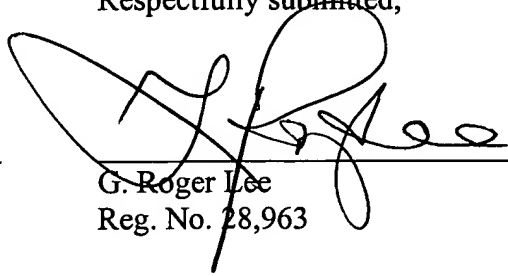
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Respectfully submitted,

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6/27/01


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